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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,826	08/09/2001	Yuri Kazakevich	00167-428001	4667

7590

11/19/2002

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EXAMINER

MULCAHY, JOHN M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SM.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/925,826	KAZAKEVICH, YURI	
	<b>Examiner</b>	<b>Art Unit</b>	
	John M. Mulcahy	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no enabling description of an embodiment having both a pinion and rack as in claim 21 and/or a push rod as in claim 20 as well as a chain and sprocket as in claim 19 (from which claim 20 depends). In action on the merits, claim 20 was interpreted as depending from claim 17, as is believed to have been intended.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- a. Claims 1, 2 and 6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hori et al. (5,989,182).
- b. Claims 1, 2 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Thompson (6,007,484).

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c. Claims 14, 17, 18, 23 and 24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wilk et al. (WO 93/15648). See Figs. 7 and 8 and their description.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a. Claims 1, 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klieman et al. (5,827,323) in view of the Examiner's official notice.

Klieman et al. clearly shows the endoscope substantially as claimed (Figs. 2, 10 and 11; note fiberscope 62 inherently including an imager –imaging fiber), but fails to specify an objective lens. However, it would have been obvious to the artisan to modify Klieman by adding such an objective lens since the Examiner takes official notice that it was notoriously old and well known in the art to employ such a lens and the artisan would expect such to improve the surgeon's view of the operating field.

b. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hori et al. (5,989,182) in view of the Examiner's official notice.

Hori et al. fails to show a chain and sprocket. Rather a cable 50 and axle 36 are used. However, the Examiner takes official notice that it was notoriously old and well known to use a chain and sprocket for analogous purpose. It would have been obvious

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to the artisan to modify Hori et al. by using a chain and sprocket in place of the cable and axle since the artisan would expect such to work equally as well.

c. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hori et al. (5,989,182) in view of the Examiner's official notice.

Hori et al. fails to show fluid or air ports. However, the Examiner takes official notice that it was notoriously old and well known to provide such fluid and air ports on analogous endoscopes. It would have been obvious to the artisan to modify Hori et al. by adding such ports since such would allow the objective lens to be cleaned *in situ*.

d. Claims 9, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hori et al. (5,989,182) as applied to claims 1 and 3-6 above, further in view of Wilk et al. (WO 93/15648).

Hori et al. fails to show a transmitter. However, Wilk et al. teach an analogous endoscope having a transmitter 156 and power source 158. It would have been obvious to the artisan to modify Hori et al. by adding such a transmitter, etc., since Wilk et al. teach such to be advantageous.

e. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (6,007,484) as applied to claim 12 above, further in view of Mattson-Boze et al. (6,097,423).

Thompson fails to show an angle position sensor configured to provide information to a camera control unit to maintain a right side up image while the imaging probe rotates about the longitudinal axis. However, Mattson-Boze et al. teaches such an arrangement. It would have been obvious to the artisan to modify Thompson by

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adding such a sensor since Mattson-Boze et al. teaches that such would prevent the surgeon from becoming disoriented.

f. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klieman et al. (5,827,323) as applied to claims 1, 4 and 5 above, further in view of Wilk et al. (WO 93/15648).

Klieman et al. fails to show a transmitter. However, Wilk et al. teach an analogous endoscope having a transmitter 156 and power source 158. It would have been obvious to the artisan to modify Klieman et al. by employing a distal CCD and transmitter, etc., rather than the disclosed fiberscope since Wilk et al. teach such to be advantageous.

g. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (6,007,484) as applied to claims 1 and 12 above, further in view of Wilk et al. (WO 93/15648); Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (6,007,484) in view of Mattson-Boze et al. (6,097,423) as applied to claims 13 above, further in view of Wilk et al. (WO 93/15648).

Thompson fails to show a transmitter. However, Wilk et al. teach an analogous endoscope having a transmitter 156 and power source 158. It would have been obvious to the artisan to modify Thompson by adding such a transmitter since Wilk et al. teach such to be advantageous.

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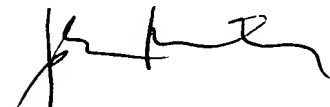
***Allowable Subject Matter***

4. Claims 10, 11, 15 and 16 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Mulcahy whose telephone number is (703) 308-3134. The examiner can normally be reached on M-F, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0873.



John Mulcahy  
November 18, 2002

John M. Mulcahy  
Primary Examiner  
Art Unit 3739